



AF-70

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Application of  
Myron L. Munn

Serial No.: 10/829,005

Filed: April 21, 2004

Title: OIL FILTER ADAPTER

Group No.: 1723

BEFORE THE BOARD  
OF PATENT APPEALS  
AND INTERFERENCES

Appeal No. \_\_\_\_\_

APPELLANT'S REPLY BRIEF TO EXAMINER'S ANSWER

Commissioner for Patents  
Alexandria, VA 22313

Dear Sir:

In the Examiner's Answer, at page 6 thereof, the Examiner argues that the preamble relies upon the intended use of the oil filter and does not add any structural limitation to the claimed oil filter adapter. The Examiner is apparently unaware of the applicable case law. A claim preamble has the import that a claim as a whole suggests for it. Bell Comm. Research v. Vitalink Comm. Corp., 55 F.3d 615, 34 USPQ2d 1816 (Fed. Cir. 1995). Generally, the preamble does not limit the claim. DeGeorge v. Bernier, 768 F.2d 1318, 226 USPQ 758 (Fed. Cir. 1985). However, statements appearing in the preamble may be necessary to give meaning to the claim and properly define the invention. Bell Comm. Research v. Vitalink Comm. Corp., 55 F.3d 615, 34 USPQ2d 1816 (Fed. Cir. 1995). Whether a preamble stating

1 an intended purpose constitutes a limitation to the claim depends on whether the  
language is essential to particularly point out the invention. Diversitech Corp. v.  
Century Steps, Inc., 850 F.2d 675, 7 USPQ 1315 (Fed. Cir. 1988). The Federal  
Circuit has said that a term that breathes life into the claims is a necessary limitation  
5 even though it appears in the preamble. Loctite Corp. v. Ultraseal Ltd., 781 F.2d  
861, 228 USPQ 90 (Fed. Cir. 1985).

In this case, the preamble does breathe life into the claims and is a necessary  
limitation. The prior art relied upon by the Examiner does not anticipate the claimed  
10 subject matter under 35 U.S.C. § 102 nor does the prior art make the claimed subject  
matter obvious under 35 U.S.C. § 103. Accordingly, Appellant contends that the  
Examiner's final rejection should be reversed.

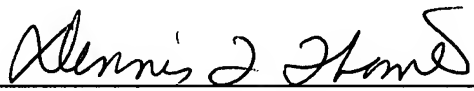
Respectfully submitted,

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CERTIFICATE OF MAILING

I hereby certify that the original of APPELLANT'S REPLY TO EXAMINER'S ANSWER for MYRON L. MUNN, Serial No. 10/829,005, was mailed by first class mail, postage prepaid, to the Mail Stop Appeal Briefs-Patent, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 10<sup>th</sup> day of July, 2007.

  
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DENNIS L. THOMTE